



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/282,145 03/31/99 SCHOENWOLF

G P98.2881

026574
SCHIFF HARDIN & WAITE
6600 SEARS TOWER
233 S WACKER DR
CHICAGO IL 60606-6473

TM02/0629

EXAMINER

CORRIELUS, J

ART UNIT

PAPER NUMBER

2172

DATE MAILED:

06/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/282,145

Applicant(s)

SCHOENWOLF ET AL.

Examiner

Jean M Corrielus

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3&4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Art Unit: 2172:

DETAILED ACTION

1. This first office action is in response to application filed on 03/31/99 (paper no.1) in which claims 1-16 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement filed on June 14, 1999 and February 28, 2000 (paper no.3&4 respectively) complies with the provisions of M.E.P.. § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 19819205.3, filed on 04/29/1998, which papers have been placed of record in the file.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2172:

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pathakis et al. US Patent no. 5,946,467

As to claim 1, Freund discloses "a database for permanent data" (col.2, lines 28-30); "a buffer into which is written all data to be permanently stored" (col.2, lines 30-33); "a permanent memory connected to the buffer, the permanent memory having at least two storage areas in each of which all permanent data from the buffer is stored" (col.2, lines 30-33).

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2172:

7. Claims 2-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pathakis et al. US Patent no. 5,946,467 in view of Krueger et al US Patent no. 5,634,050.

As to claims 2-16, Pathakis discloses substantially the invention as claimed, except for the use of a loadable Flash Erasable Programmable Read Only Memory Chip.

Krueger, on the other, discloses the use of a loadable Flash Erasable Programmable Read Only Memory Chip (Abstract; col.2, lines 11-45).

It would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to modify the Pathakis' system, wherein the storage device provided thereof (see Pathakis' Fig.1, item 14-16) would incorporate the use of a loadable Flash Erasable Programmable Read Only Memory Chip in the same conventional manner as suggested by Krueger. One having ordinary skill in the art would have been motivated to do so because such of modification would provide Pathakis the enhanced capability of allowing a file to be written to the storage device and then selectively modified by changing some bits of the file.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or early communication from the Examiner should be directed to **Jean M. Corrielus** whose telephone number is (703)306-3035. The Examiner can normally be reached on Tuesday-Friday from 7:00am to 5:30pm.

Serial Number: 09/282,145:

Page 5

Art Unit: 2172:

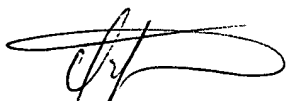
If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu, can be reached on Monday-Friday from 9:00 a.m.-6:00 p.m. at (703)305-4393.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications intended for entry)

Or: (703)305-9731 (for informal or draft communications, please label "PROPOSED" or "DRAFT") Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-9600.



Jean M. Corrielus

Patent Examiner

June 26, 2001